



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/008,148	01/16/98	FRUITMAN	C 29131.0217

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EXAMINER

MORGAN, E

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 07/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 3723

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 4-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-13,16-19,1,2 of U.S. Patent No. 5,769,691.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is directed to planarizing a workpiece with a lapping surface and the patent claims planarizing a silicon wafer with a lapping pad. This is an obvious variation over the patented subject matter and the term "pad" would include a "soft and pliable material."

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronay 5,752,875 in view of Samuelson-4,048,765.

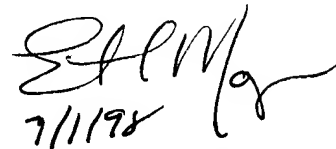
5. Ronay discloses polishing a wafer with a pad and a slurry solution of silica and a hydroxide with the claimed size range and weight percentage. Ronay discloses a polyurethane pad to polish wafer but not specifically a non-cellular pad. However, Samuelson teaches polishing with a non-cellular pad of non-cellular urethane that is flexible and free to deform with workpiece. Therefore, it would have been obvious to one of ordinary at time invention was made to substitute the pad in Ronay with a non-cellular pad, as taught by Samuelson, in order to increase the heat distortion, decrease the friction, and prevent clogging and build-up, therefore, increasing pad life to 3-5 times that of other pads.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Morgan whose telephone number is (703) 308-1743.


7/1/98
EILEEN P. MORGAN
PRIMARY EXAMINER

EM

July 1, 1998